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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,876	09/23/2004	Mitsunori Matsushima	2101-18	1122
23117 7590 07/12/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
			EXAMINER BUTTNER, DAVID J	
			ART UNIT 1712	PAPER NUMBER
			MAIL DATE 07/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/508,876	MATSUSHIMA ET AL.	
	Examiner	Art Unit	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, and 13-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the claims require a shaped member that :

- (1) inherently has the capability to transmit a laser beam
- or (2) that the shaped member is presently transmitting a laser beam
- or (3) if the shaped article has been bonded to its counterpart by transmission of a laser beam.

It is unclear if the "3mm thickness" is a limitation of the claimed shaped member or merely refers to a test procedure that the composition must pass.

It is unclear if the claimed shaped member must be formed by injection molding or merely that the testing procedure on the composition involves injection molding.

Claims 10 and 13-17 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kobayashi 2004/0084140.

Kobayashi exemplifies (table 2) laser weldable compositions of polyethylene terephthalate, glass fibers and a polybutylene terephthalate that includes some ethoxylated BPA comonomer.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 10 and 13-17 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP2000007902.

The reference exemplifies (#7,11) blends of 100 parts of 12% isophthalate modified polybutyleneterephthalate, 20 parts styrene resin, 10 parts polycarbonate and 40 parts glass fiber. Additionally, comparison #7 shows 100 parts of 12% isophthalate modified polybutyleneterephthalate, 10 parts polycarbonate and 40 parts glass fiber. Inherently, the composition must have the properties of applicant's claims because it is the preferred composition used by applicant.

Claims 10,13,14 and 17 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP05032800.

The reference is believed to exemplify (#1,#4) blends of 80% copolyester and 20% polycarbonate. The copolyester is made of butanediol and terephthalic/isophthalic acid in a 80-87.5/20-12.5. Additionally, example 5 is a blend of 80% of a ethoxylated bisphenol A modified PBT and 20% polycarbonate. Inherently, the compositions must have the properties of applicant's claims because it is the preferred composition used by applicant.

Claims 10 and 13-17 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Uno 2002/0188073.

Uno's comparison example 8 is a blend of 35% polybutyleneterephthalate/isophthalate copolymer, 35% polycarbonate and 30% glass fibers (table 2). The polyester has a terephthalic/isophthalic ratio of 85/15 (paragraph 59).

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Inherently, the composition must have the properties of applicant's claims because it is the preferred composition used by applicant.

Claims 10 and 13-17 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP11049937.

Example 5 is a blend of 100 parts of 12% isophthalic acid modified polybutyleneterephthalate, 30 parts polycarbonate, 10 parts glass fiber and 0.3 parts phosphite. Inherently, the composition must have the properties of applicant's claims because it is the preferred composition used by applicant.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10 and 13-17 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10-574574. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the copending application also claims (eg #2,11) laser weldable compositions and articles of modified PBT, polycarbonate and glassy filler (#8).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed 6/4/07 have been fully considered but they are not persuasive.

Applicant's claims in their current state appear to merely require a shaped member of a certain composition that has a capability to transmit laser beams and that the composition has a certain light transmittance when subjected to a certain test. Laser welding appears to be merely a future unintended use for the shaped member.

Applicant again argues that the references do not suggest laser welding their compositions.

The claims do not appear to require laser welding. Future intended uses do not limit the claim. Recognition of latent properties (eg laser weldability, light transmissivity) of previously known compositions cannot be the basis of patentability (MPEP 2145 II.).

Applicant fails to identify ANY material difference between the compositions of the cited references and the claims. The cited reference compositions must inherently have the required laser weldability and light transmission. No other conclusion is possible. Simply measuring properties of known compositions and inserting these properties into the claims will not result in a finding of patentability.

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If applicant amends or intends the claims to require laser welding, then the claims conflict with child application 11-651069. If that is the case, the two applications should be merged.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

DAVID J. BUTTNER
PRIMARY EXAMINER

7/6/07

